

## **REMARKS**

The amendments to the claims find support in the specification and claims as originally filed. Claims 4, 6, 7, 9-12, and 14 have been amended to incorporate all the recitations of original Claim 1 and intervening dependent claims. Thus, Claim 4 has been amended to incorporate the recitations of Claims 1 and 3; Claims 6 and 7 have been amended to incorporate the recitations of Claims 1 and 5; claim 9 has been amended to incorporate the recitations of Claims 1 and 8; Claims 10-12 have been amended to depend from Claim 9, and so to also incorporate the recitations of Claims 1 and 8; and Claim 14 has been amended to incorporate the recitations of Claims 1 and 13. Where the word "product" was found in an earlier claim, the claim amendments replace it with "polypeptide," support for such substitutions where may be found, for example, at page 6, paragraph 24, discussing modifications in the polypeptide sequence of GFP which lead to formation of products, which may be referred to as a polypeptide (see, e.g., lines 5-8 of paragraph 24). Other claim amendments correct minor typographical errors. New Claim 24 finds support in the specification at, for example, paragraph 33, lines 7-10 of the paragraph, on page 10.

No new matter is added by way of the amendments to the claims.

Entry of new Claim 24 is respectfully requested. New Claim 24 depends from Claims 4, 6, 7, 9, and 14, including all the recitations of those claims, and further recites amino acid substitutions that have been disclosed in the specification as having no significant impact on the properties of the claimed fluorescent polypeptides. Thus, the subject matter of new Claim 24 is fully supported in the specification. Claim 24 depends from claims that recite novel sequences and further includes substitutions in those novel sequences that are disclosed in the specification to be neutral substitutions. Thus, the subject matter of Claim 24 being neutral substitutions within novel sequences, it is believed that no new search is required, and Claim 24 is believed to be allowable.

Claims 1-15 are pending in the application and were examined in the Office Action. Claims 1-3, 5, 8, and 13 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed had possession of the claimed invention; and under 35 U.S.C. §112, first paragraph, as allegedly not being enabled by the specification. Claims 1-15 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 6, 7, 9-12, 14 and 15 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112, second paragraph, and to include all of the recitations of the base claim and any intervening claims.

Applicants respectfully traverse the rejections as discussed below.

#### **The Rejections Under 35 U.S.C. §112, First Paragraph**

Claims 1-3, 5, 8, and 13 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention, and as allegedly not being enabled by the specification.

With the present amendment, Claims 1-3, 5, 8, and 13 stand canceled without acquiescing to the rejections and without prejudice to prosecution of the same or related subject matter in related continuation, continuation-in-part, or divisional applications. Accordingly the rejections under 35 U.S.C. §112, first paragraph, are believed to be moot.

### **The Rejections of Claims 1-15 Under 35 U.S.C. §112, Second Paragraph**

Claim 1 and its dependent Claims 2-15 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention.

The terms “a modified form of an *Aequorea* wild-type GFP” and “a fluorescent product” both appearing in Claim 1, the claims are alleged to be unclear. As amended, Claim 1 being canceled and the term “product” not appearing in the pending claims, Applicants respectfully submit that the ground for rejection is overcome.

The term “derived” is alleged to make claim 8 unclear. Claim 8 standing canceled, and the word “derived” not appearing in any claim, Applicants submit that this ground of rejection is also overcome.

Accordingly, the terms that were objected to as allegedly unclear not appearing in the pending claims, Applicants believe the rejections to Claims 1-15 under 35 U.S.C. §112, second paragraph, to be overcome.

### **Allowable Subject Matter**

Applicants note the Examiner’s statement that “Claims 4, 6, 7, 9-12, 14, and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office Action and to include all of the recitations of the base claim and any intervening claims.

Claims 4, 6, 7, 9, and 14 being rewritten to include all of the recitations of the base claim and any intervening claims, Claims 10, 11, 12, and 15 depending from these claims, and the claims being rewritten where appropriate to overcome the rejections under 35 U.S.C. 112, second paragraph, Applicants submit that the rejections to Claims 1-15 are overcome.

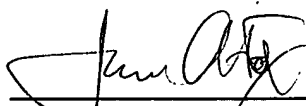
### **CONCLUSION**

Applicants respectfully submit that the rejections of Claims 1-15 are overcome, that all claims are in condition for allowance, and request reconsideration and allowance of all pending claims. The Examiner is invited to contact the undersigned attorney at the telephone number indicated below should he find that there are any further issues outstanding.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. **08-1641** citing Attorney's Docket No. **39754-0861 CPDV3C1**.

Respectfully submitted,

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By:   
James A. Fox (Reg. No. 38,455)

**HELLER, EHRMAN WHITE & McAULIFFE LLP**  
275 Middlefield Road  
Menlo Park, California 94025-3506  
Telephone: (650) 324-6951  
Facsimile: (650) 324-0638

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